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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/701,058
Filing Date: November 04, 2003
Appellant(s): SEDLAK ET AL.

Laura C. Brutman
DICKSTEIN SHAPIRO LLP
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed October 1, 2010 appealing from the Office action mailed May 18, 2010.

(1) Real Party in Interest

The statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,761,517	DURHAM ET AL.	06-1998
5,943,203	WANG	08-1999

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3, 4, 6, 7, and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 1, 4, and 7, as explained above, the Examiner doesn't believe that the Applicant's specification explicitly teaches the idea of "adjusting the clock frequency non-incrementally." The Examiner believes that the Applicant's specification teaches the same method of adjusting the clock frequency as Durham.

3. Claims 1, 3, 4, 6, 7, and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no enabling disclosure regarding how Applicants' given circuit is able to do what is now claimed, that being the non-incremental adjustment of the clock frequency.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1, 3, 4, 6, 7, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 1, 4, and 7, the Applicant uses the phrase “adjusting the clock frequency non-incrementally,” and the Examiner feels that the meaning of the term “non-incrementally” is indefinite in light of the description in the specification providing no support for that term. The Examiner will base his claim interpretation of the term “non-incrementally” on the method of adjusting the clock frequency as described in the Applicant’s specification. Also, as explained above, the Examiner feels that the method of adjusting the clock frequency (by suppressing individual clock pulses) described in the Applicant’s specification is analogous to the method described in the Durham reference.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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7. Claims 1, 3, 4, 6, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durham et al. (5,761,517) and Wang (5,943,203). Durham teaches a current measuring device (18), a controllable clock supply circuit (27, 19, 1-7, 10-13, 20) having an output with filtered clock pulses to be connected to a clock input of the circuit configuration (20, system_clock), and a clock generator (27) generating a constant maximum internal frequency. He also teaches a control device (21 & 14-17), connected to and controlling a pulse filter (1-7, 10-13, 20), which drives the filtered clock (via control signals sent via 16 and 17) based upon the measured current consumption (via sensor, 18). He also teaches the pulse filter (1-7, 10-13, 20) suppressing individual clock pulses of the clock generator (27) instantaneously and non-incrementally when a high power condition is detected (via sensor, 18), in response to the control signal at the pulse filter's control input (new_data of registers 10-13). It is inherent to detect if such a condition exists, to have a definable threshold value and to see if the measured value exceeds it. (Abstract; Col. 1, lines 53-59; Col. 6, lines 24-52; Fig. 1A&B) Durham fails to explicitly teach the sensor being instantaneous and how the sensor (18) determines that a high power condition exists. Wang teaches a current being measured by an instantaneous current sensor and then compared with a threshold value by a comparator to determine if an over-current state has occurred (Col. 4, lines 14-19). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Wang's method of determining over-current into Durham's invention since Durham doesn't teach how it is determined and Wang teaches a method known in the art. It also would have been obvious to one of ordinary skill in the art at the time of the invention to use an instantaneous current sensor and instantaneous adjustment of clock frequency in

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Durham's invention to allow for more accurate measurements of the current and more precise control of the clock's frequency.

(10) Response to Argument

Regarding the Appellant's use of the word "non-incrementally", the Appellant argues that the specification does not describe an incremental reduction/increase in clock frequency, nor suggest a state machine for switching between different levels, therefore the clock frequency must be adjusted non-incrementally.

This argument is not persuasive. The Examiner believes that this does not mean that the present invention's clock frequency must be adjusted non-incrementally. Looking at the term broadly, given the general dictionary definition of the term, "incremental" could mean any change (e.g., a single increment or step). Based on the Appellant's specification and the Durham reference teachings of filtering out individual clock pulses, if there are 5 clock pulses in a row then the sixth is suppressed/filtered out, then the clock frequency was just adjusted incrementally. The suppression/filtering of a single clock pulse can be considered an incremental adjustment, since there was a change from suppressing/filtering no clock pulses to suppressing/filtering a single clock pulse. Thus, Appellant's argument that their suppressing/filtering of clock pulses must be performed non-incrementally is not persuasive. The Examiner believes that part of the reason the term "non-incrementally" was added to the claim language was not that it was taught in the Appellant's specification (because it was not), but because the term "incrementally" was taught in the Durham reference. There is no support in the Appellant's specification to describe the method of adjusting the clock frequency as being non-incremental.

Regarding the Appellant's assertion that Durham's frequency levels are not adjusted directly in response to a control signal, Durham's pulse filter is comprised of reference numbers

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1-7, 10-13, and 20, the control device is comprised of reference numbers 21 and 14-17, and the control signal is comprised of the outputs from control device elements 16 and 17 to elements in the pulse filter; therefore one of ordinary skill in the art could recognize Figs. 1A and 1B showing/suggesting the sensor (18) being connected to a control device, which has an output (sending control signals) connected to an input of a pulse filter, wherein the pulse filter is in series with and in between an oscillator clock and an outputted filtered clock signal. Therefore, one could say that the pulse filter of Durham suppresses clock pulses directly in response to said control signal from the control device. Figs. 1A and 1B are just detailed drawings of the control device and the pulse filter.

Also, regarding the Examiner's argument for inherency in the Final Rejection, Durham teaches detecting if a certain condition exists based on the measured current value. The only way to detect if a certain condition exists is to compare the measured current value to another current value (i.e. a definable threshold value). Therefore, there has to be a definable threshold value because there is no way to determine if the measured current value is too high without defining what "too high" means.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Dru Parries

/Jared J. Fureman/

Supervisory Patent Examiner, Art Unit 2836

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